



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,027	01/23/2004	Makoto Takayanagi	TSU-TRI-P20	7947
26793	7590	09/25/2006	EXAMINER	
LEIGHTON K. CHONG GODBAY GRIFFITHS REISS & CHONG 1001 BISHOP STREET, PAUHI TOWER SUITE 2300 HONOLULU, HI 96813			BENENSON, BORIS	
			ART UNIT	PAPER NUMBER
			2836	

DATE MAILED: 09/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/764,027		TAKAYANAGI, MAKOTO	
	Examiner		Art Unit	
	Boris Benenson		2836	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 and 16-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-10, 13 and 14 is/are rejected.
- 7) ☐ Claim(s) 11, 12 and 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Actions

1. Amendment in response to Election/Restriction Requirements received on 9/05/2006 is entered.

- a. Claims 1-7 and 21-35 are withdrawn.
- b. Claims 9-11, 16-18 and 18-20 are amended.

Election/Restrictions

2. Applicant's election with traverse of Species I, as illustrated in Figs. 1-5 in the reply filed on 9/05/2006 is acknowledged. The traversal is on the ground(s) that Claim 8 is deemed to be generic to all of Species 1-4 (Figs.1-13). This is not found persuasive because embodiments shown in details in Figures 1-5 represent a specific physical structure of a static eliminator. The structure represents a separate invention and does not require such elements of Species 2-4 as discharge whiskers, a conductor with a discharge halt voltage, and any specifics of applied voltages.

The requirement is still deemed proper and is therefore made FINAL.

3. Amended Claims 16-20 are related to unelected species and therefore withdrawn from consideration.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 8-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The language of independent Claim 8 requires a static eliminator, which comprises a board tape. The term "board tape" is not defined in the Claims or in the Specification and therefore indefinite. Claims 9-15 didn't correct indicated indefiniteness. According to Merriam-Webster's Collegiate Dictionary Tape is defined as "a narrow flexible strip or band". For examination purposes term "board tape" will be interpreted as *a strip of a board*.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2836

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 8-10, and 13 are rejected under 35 U.S.C. 102(a) as being anticipated by Gagnon et al. (6,647,242). Gagnon et al. disclose a Flexible Conductive Plastic Static Control Device comprising a strip (Figs. 1-4, Pos.30). Gagnon et al. disclose, "static control device 10 includes a carrier strip 30, a segment of which is shown in FIGS. 2 and 4. Carrier strip 30 is an elongated body having a length indicated by line 32 in FIG. 4, between ends 34 and 36. Lateral edges 38 and 40 extend along length 32, from end 34 to end 36" (Col.4, Lines 5-8). Gagnon et al. also disclose, "A plurality of bundles 50, each having a plurality of filaments 52, is provided along carrier strip length 32. Filaments 52 can be carbon fiber, stainless steel fiber, conductive acrylic fiber or any conductive fiber type filament that can be provided with diameters sufficiently small to induce ionization when in the presence of an electrical field. Filaments 52 are very fine hair-like structures" (Col.4, Lines 28-34). Bundles with filaments constitute a plurality of discharge electrodes.

Art Unit: 2836

Referring to Claim 9, Gagnon et al. disclose a contact adhesive (Fig.3, Pos. 60) read on cover tape that covers bangles (Pos.50).

Referring to Claim 13, Gagnon et al. disclose, "Carrier strip 30 is a flexible body of non-metallic conductive material such as conductive plastic" (Col. 4, Lines 12-13).

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 8-10, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Simons (4,216,518). Simons disclosed a Capacitively Coupled Static Eliminator With High Voltage Shield. Simons disclosed strips (Fig.4, Pos 30) to which a plurality of electrodes (28) is connected. "The plates 30 may be formed in any suitable manner, such as by way of deposition of a conductive material upon the surface of an insulative strip, to define a plurality of longitudinally spaced islands to which the pointed needles 28 are conveniently affixed, such as by stapling" (Col.4, Lines 54-59).

Referring to Claim 9, each of the plurality of electrodes is covered by a cover tape (Fig. 4A, Pos.36, 38). Simons disclosed "a pair of conductive ribbons, rods or bars 36 and 38 extend

Art Unit: 2836

longitudinally through the yoke 34 above the plates 30 on each side of the needles 28" (Col. 5, Lines 30-34). Those ribbons rods or bars above the plates read on the limitation "a cover tape".

Referring to Claim 10, electrodes (Fig. 7, Pos. 28) are disposed in parallel to each other.

Referring to Claim 14, a central conductive bus (Fig. 4, Pos. 24) represents an electronic circuit pattern.

Allowable Subject Matter

7. Claims 11, 12, and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and if rejection under 35 U.S.C. 112 is overcome.

The following is an examiner's statement of reasons
for *indicating* allowable subject matter:

8. Claims 11 and 12 would be allowable because none of the prior art of record disclose a static eliminator wherein leading ends of discharge electrodes oriented in opposite directions to

Art Unit: 2836

opposite sides of a tape and wherein holders for the electrodes are provided on opposite ends of the tape in combination with the other claim limitations.

9. Claim 15 would be allowable because none of the prior art of record disclose a static eliminator wherein a sockets for exchanging electrodes are disposed on a tape.

Contact information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boris Benenson whose telephone number is (571) 272-2048. The examiner can normally be reached on M-F (8:20-6:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Sircus can be reached on (571) 272-2800 ext 36. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through

Art Unit: 2836

Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Boris Benenson
Examiner
Art Unit 2836

B.B.



BRIAN SIRCUS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800